

REMARKS/ARGUMENTS

I. Status of Claims

Claims 1 and 10 are amended.

Claims 2, 18, and 19 are canceled.

Claims 3-9, 13-17 and 20-47 are withdrawn.

Claims 1 and 10-12 are being examined.

Support for the claim amendments are found through out the specification and original claims as filed.

II. Claims 1 and 10-12 Satisfy 35 U.S.C. §112 2nd Paragraph Requirements

On page 3 of the Office Action, the examiner rejected claim 1 under 35 U.S.C. §112 2nd paragraph because the examiner alleges the term "starting material monomer" is "not clearly defined in the specification".

There is no case law requirement that every claim term needs to be "clearly defined" in order to satisfy the definiteness requirement of §112. See for e.g., a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004) (holding that the disputed claim term "surrender value protected investment credits" which was not defined or used in the specification was discernible and hence not indefinite because "the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence"). The test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986).

The MPEP further highlights the importance of claim-as-a-whole analysis:

Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

(A) The content of the particular application disclosure;

(B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim appraises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph.

MPEP 2173.02.

To the contrary, the examiner has provided no reason as to why the phrase “starting material monomer” is indefinite other than indicating that the term is “not clearly defined in the specification”. In polymer chemistry, a person of ordinary skill in the art would readily comprehend what the phrase “starting material monomer” means based on the disclosure in the specification.

Nevertheless, to expedite prosecution, without prejudice, applicants amend claim 1 to indicate that the starting material monomer is (meth)acrylic monomer.

The term “incorporates” in claim 1 has been replaced with “comprises”.

With respect to the dashes that appear on either end of the structure (Ie) in claim 3 (now in amended claim 1), the specification and claim 1 itself clearly mention that the compound embodied by (Ie) is a “partial structure” and therefore the dashes represent a linkage/bond. Support for this is found for example on p. 11, first paragraph, p.33, line 1 to p. 35, line 3, claims 3, 11, and 12 as originally filed.

Therefore, the applicants request §112 rejections over claims 1 and 10-12 be withdrawn.

III. Claim 1 is Novel Over Song et al., (1996) under 35 U.S.C. §102(b).

Song et al. does not describe the composition of claim 1. Applicants request withdrawal of this rejection. Song, at least does not teach the claimed hydrophilic spacer.

IV. Claim 1 is Novel Over Cook et al., (1993) under 35 U.S.C. §102(b).

Cook et al. does not describe the composition of claim 1. Applicants request withdrawal of this rejection. Cook, at least does not teach the claimed hydrophilic spacer.

V. Claim 1 is Novel Over Rehmer et al., (U.S. Pat. No. 5,073,611) under 35 U.S.C. §102(b).

Rehmer et al. does not describe the composition of claim 1. A patent is invalid as anticipated under 35 U.S.C. § 102 if a prior art reference discloses every limitation of the claimed invention. *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1381 (Fed. Cir. 2007). Rehmer, at least does not teach the claimed hydrophilic spacer. Applicants request withdrawal of this rejection.

V. Claims 1 and 10-12 are Not Obvious Over Rehmer et al., (U.S. Pat. No. 5,073,611) under 35 U.S.C. §103(a).

Rehmer et al. neither describes nor suggests the composition of claims 1 and 10-12. For example, the structure (Ic) of amended claim 1 has a minimum of one additional $-\text{CH}_2\text{CH}_2\text{O}-$ unit (when r is 1) over Compound B1 of Rehmer. The additional $-\text{CH}_2\text{CH}_2\text{O}-$ unit in the claimed hydrophilic spacer is not suggested in Rehmer. In addition, Rehmer does not mention use of Compound B1 in affinity chromatography where the claimed hydrophilic spacer is used as part of an affinity resin. Rehmer merely relates to UV-curable polymers that are used as hotmelt adhesives. The additional $-\text{CH}_2\text{CH}_2\text{O}-$ unit offers additional length for the spacer and may also play a role in the hydrophilic/hydrophobic balance of the attaching moieties. The examiner did not provide any evidence to show that Compound B1 of Rehmer that differs from the claimed structure possesses similar property other than mentioning that the structures are “generally of sufficiently close structural similarity”. Spacer lengths in hydrophilic spacers such as (Ic) that differ in the length of the repeating groups are of significance for the intended uses. Applicants request withdrawal of this rejection.

No other fees are due. However, please charge any fees that might be due in connection with this submission to our Deposit Account No. 12-0913 with respect to our matter number 43512-104208.

Respectfully submitted,

Date: August 31, 2009

Sendil k. Devadas

Sendil k. Devadas, Reg. No. 52,425
BARNES & THORNBURG LLP
P.O. Box 2786
Chicago, Illinois 60690-2786

(312) 357-1313 (telephone)

(312) 759-5646 (facsimile)